UNITED STATES PATENT AND TRADEMARK OFFICE

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10/772,476	02/05/2004	Michael K. Brown	13210-140	4975

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EXAMINER
LAI, MICHAEL C

ART UNIT	PAPER NUMBER
2457	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/772,476	BROWN ET AL.
Office Action Summary	Examiner	Art Unit	
	MICHAEL C. LAI	2457	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 April 2009</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,7-14,23,29-36,45 and 46</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,7-14,23,29-36,45 and 46</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   **Office Action Summary**   Part of Paper No./Mail Date 20090728

DETAILED ACTION

This office action is responsive to amendment filed on 4/7/2009.

Response to Amendment

The examiner has acknowledged the amended claims 1, 23, 45, and cancelled

claims 5-6, 27-28. The 112 second paragraph rejection to claims 1, 6, 23, 28, and 45

has been overcome and withdrawn accordingly. Claims 1, 7-14, 23, 29-36, and 45-46

are pending.

Response to Arguments

Applicant's arguments filed 4/7/2009 have been fully considered but they are not

persuasive.

In the remarks, the applicant argues in substance that: A) Kasai fails to teach that

the "new format compatible with the processing server" is HTML. In the event that the

cited references fail to disclose or suggest all of the elements recited in the claims, then

combining elements from the references would not yield the claimed subject matter,

regardless of the extent of any teaching, suggestion or motivation. This is strong

evidence of non-obviousness. B) It would not be obvious to a person of ordinary skill in

the art to modify the teachings of Kasai to arrive at the Applicants' claimed

embodiments. The Examiner suggests on page 5 of the office action that it would be

obvious to modify Kasai to use HTML in the translation of e-mails. It is worth noting that

the Examiner based many of the obviousness references upon a single reference,

namely Kasai. C) Applicants' proxy does not just extract text information for processing

in the processing server. The proxy converts the format of a message, sent according to

one communication protocol by the mobile device, into a new format (i.e. HTML) to be

compatible with a different network device, i.e. the processing server, which operates

using a different communication protocol. This format conversion is not present in

Kasai.

In response to A) the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the

claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988)and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

the Examiner based many of the obviousness references upon the knowledge generally

available to one of ordinary skill in the art. Kasai teaches his invention in five

embodiments, ranging from the homepage translation system to the mail translation

system. Although the Examiner based many of the obviousness references upon a

single reference, namely Kasai, the Examiner also based many of the obviousness

references upon multiple embodiments (mainly the first and the fourth embodiments) of

the reference, not just a single embodiment. In this case, it is known to a person skilled

in the art that emails can be sent in several formats including HTML. And because of

the high versatility of HTML, a person skilled in the art would certainly consider this

language to solve the problem of translation of emails using different formats in Kasai's

fourth embodiment. Thus, it would have been obvious to a person with ordinary skill in

the art at the time the invention was made to convert from a text format into HTML

before sending the message to the processing server as a choice of options, thereby

solving the problem of translation of emails using different formats.

In response to B) please see the response to A), since A) and B) are similar.

In response to C) it is known to a person skilled in the art that emails can be sent

in several formats including HTML. And because of the high versatility of HTML, a

person skilled in the art would certainly consider this language to solve the problem of

translation of emails using different formats in Kasai's fourth embodiment. The use of

HTML is therefore considered as an obvious choice of options to a person skilled in the

art. Kasai's fifth embodiment further discloses that the data accept module 42 of the

server performs format conversion for messages received from the client device before

sending to the translation processing module 43 for translation (see Kasai FIG. 18 and

col. 22 line 22 through col. 23 line 67). In view of such, Kasai does teach "performing

an intermediate act of converting text received from a mobile device into HTML for use

as input to a translation server".

In view of the foregoing, it is evident that the invention according to claims 1, 23,

and 45 is obvious under 35 U.S.C. 103(a) as being unpatentable over Kasai.

Thus, in view of such, the rejection is sustained as follows:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

    obviousness rejections set forth in this Office action:

    (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
    section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
    are such that the subject matter as a whole would have been obvious at the time the invention was made to

a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
negatived by the manner in which the invention was made.

2. Claims 1, 7-14, 23, 29-36, and 45-46 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Kasai et al. (US 7,216,072 B2, hereinafter Kasai).

Regarding claim 1, Kasai discloses a method of converting an initial message

residing in a mobile computer device capable of wireless access [FIG. 17 and

col. 11, lines 22-25, handheld terminal or cellular phone] to a computer network

into a processed message, the method comprising:

presenting a menu option to a user of the device for converting the initial

message into the processed message, wherein program instructions for

presenting the menu option originate in the mobile computer device [FIG. 3,

col. 5, lines 63-66; FIG. 17 and col. 21, lines 22-26];

after the user selects the menu option to convert, wirelessly sending text

in the initial message to at least one server on the computer network for

converting the text in the initial message into the processed message [col. 21,

lines 33-49, "Further, the translated mail server 32 sends the text information

to the translation server 33 and requests the server 33 to translate it"];

wherein the computer network comprises the Internet [FIG. 17, Translation

System on Internet] and the at least one server comprises a proxy and a

processing server requiring input in hypertext markup language [col. 9, lines

21-32, HTML data input; FIG. 17, col. 21, lines 42-49. Note that the

translated mail server (32) and the translation server (33) forming part of the

server system (1) in Kasai's reference are equivalent to the proxy (22) and
the processing server (24) in the claim];

wherein the text in the initial message is sent first to the proxy for
conversion from a text format into a new format compatible with the
processing server before sending the initial message in the new format to the
processing server, and then to the processing server [FIG. 17, col. 21, lines
42-49; Note that the proxy server (32) actually does some sort of format
conversion for the translation server (33) when extracting text from an email];
and

the proxy converting the processed message into a device- formatted
representation of the processed message, and the mobile computer device
receiving the device-formatted representation of the processed message from
the proxy [col. 6, lines 6-9, the WWW server uses HTML implying the proxy
converts the message into a device-formatted message before sending it to
the mobile device; col. 21, lines 54-56].

Kasai discloses all limitations of claim 1, except the new format being
hypertext markup language. However, it is known to a person skilled in the art
that emails can be sent in several formats including HTML. And because of the
high versatility of HTML, a person skilled in the art would certainly consider this
language to solve the problem of translation of emails using different formats in
Kasai's fourth embodiment. Thus, it would have been obvious to a person with
ordinary skill in the art at the time the invention was made to convert from a text

format into HTML before sending the message to the processing server as a
choice of options, thereby solving the problem of translation of emails using
different formats.

Regarding claim 7, Kasai discloses the method of claim 1, wherein the menu
option is a translation option, an encryption option, a spell check option or a
thesaurus option [Kasai, FIG. 3 and col. 7, lines 17-21, translation option].

Regarding claim 8, Kasai discloses the method of claim 1, wherein the text in
the initial message comprises text displayed on the mobile computer device in a
first language [Kasai, FIG. 3].

Regarding claim 9, Kasai discloses the method of claim 8, wherein the text
forms part of an email [Kasai, FIG. 9 and col. 14, lines 19-34].

Regarding claim 10, Kasai discloses the method of claim 8, wherein the text
is in a Web page [Kasai, FIG. 1, browser on the device and the WWW server
uses HTML].

Regarding claim 11, Kasai discloses the method of claim 8, wherein the menu
option is a translation option, such that when the translation option is selected, a
pop-up is displayed prompting a user of the mobile computer device to choose at
least one translation characteristic option [Kasai, FIG. 3 and col. 6-7, lines 59-
26].

Regarding claim 12, Kasai discloses the method of claim 11, wherein the pop-up prompts the user to identify the first language [Kasai, FIG. 3 and col. 6-7, lines 59-26].

Regarding claim 13, Kasai discloses the method of claim 11, wherein the pop-up prompts the user to choose a second language into which the text is to be translated [Kasai, FIG. 3 and col. 7, lines 22-26].

Regarding claim 14, Kasai discloses the method of claim 1, but silent about further comprising, before the step of presenting, automatically checking to determine whether the initial message corresponds to text in a language that is not native to a user of the mobile computer device. Official Notice is taken for checking the initial message to see if the text is in a language that is not native to the user, as this is essential for determining if a translation is needed. It would have been obvious to a person with ordinary skill in the art at the time the invention was made to do so for the purpose of avoiding unnecessary operation by determining if a translation is needed before presenting the menu to the user, thereby providing a more efficient translation system.

Claims 23, 29-36 are of the same scope as claims 1, 7-14. They are rejected for the same reason as for claims 1, 7-14 respectively.

Claim 45 is of the same scope as claim 1. It is rejected for the same reason as for claim 1.

Regarding claim 46, Kasai discloses the computer-readable medium of claim 45, wherein the initial message is in a first language, and the processed

message is in a translated language [Kasai, col. 6, lines 2-5, request/response messages].

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the

state of the art disclosed by the references cited and the objection made.

Applicant must show how the amendments avoid such references and

objections. See 37 CFR 1.111(c).

5. Hokao, US 6,907,256 B2, has taught a mobile terminal with an automatic

   translation function.

6. Hayashi Hiroto, JP 2001 251429 A, has taught a mobile voice translation system.

7. Fish, WO 02/23389 A1, has taught systems and methods for translating

   information.

Examiner's Note: Examiner has cited particular columns and line numbers in

the references applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and

are applied to specific limitations within the individual claim, other passages and

figures may apply as well. It is respectfully requested from the applicant in

preparing responses, to fully consider the references in entirety as potentially

teaching all or part of the claimed invention, as well as the context of the passage

as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully

requested to indicate the portion(s) of the specification which dictate(s) the

structure relied on for proper interpretation and also to verify and ascertain the

metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Lai whose telephone number is (571) 270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai
29JUL2009

/YVES DALENCOURT/
Primary Examiner, Art Unit 2457